



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,843	11/24/2003	David A. Schwartz	SOL.003.DIV1	5194
27111	7590	05/07/2008	EXAMINER	
GORDON & REES LLP			RUSSEL, JEFFREY E	
101 WEST BROADWAY			ART UNIT	PAPER NUMBER
SUITE 1600			1654	
SAN DIEGO, CA 92101				
NOTIFICATION DATE		DELIVERY MODE		
05/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@gordonrees.com
cworthem@gordonrees.com

Office Action Summary	Application No. 10/720,843	Applicant(s) SCHWARTZ, DAVID A.
	Examiner Jeffrey E. Russel	Art Unit 1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 March 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 5-7,35,38,49 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 35 and 38 is/are allowed.
- 6) Claim(s) 5,6,49 and 52 is/are rejected.
- 7) Claim(s) 2 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 August 2007 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

Art Unit: 1654

1. The substitute specification filed March 20, 2008 has been entered.
2. It should be noted that at least one change was made in the substitute specification without the change being marked in the marked-up copy as required by 37 CFR 1.125(c). In particular, at page 4, line 27, of the originally-filed specification, the misspelling “limited” occurs; whereas at page 5, line 24, of the marked-up copy/page 4, line 27, of the clean copy of the substitute specification, the correct spelling “limited” occurs.

The amendments to the specification filed March 20, 2008 (see pages 2 to 14 of Applicant’s response), have not been entered. It appears that these amendments were merely intended to show particular changes contained in the substitute specification. However, the changes shown in these amendments do not correspond to the changes made in the substitute specification. See, e.g., the amended paragraph on page 1, lines 2-6, and the amended paragraph on page 9, line 26 to page 10, line 24 (“maybe” vs. “may be”).

With respect to the listing of claims contained in the amendment filed March 20, 2008, the listing of claims does not accurately mark all changes made to the claims as required by 37 CFR 1.121(c)(2). In particular, at claim 5, line 15, “L¹” has been changed to “L” without the change being marked. The status identifier for claim 6 is incorrect: the claim should have been identified as “(Currently Amended)”.

3. The amendment filed March 20, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The clean copy of the substitute specification at page 46, line 18, recites a SANH/PBS solution, which constitutes new matter. Lines 16-17

Art Unit: 1654

make clear that DMSO is also present in this solution. Accordingly, at line 18, "SANH/PBS" should be changed to "SANH/DMSO/PBS".

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 6, 49, and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no original disclosure supporting the recitation in claim 5 that R¹ and R² can be methyl. The original disclosure (see, e.g., page 22, lines 24-27, of the clean copy of the substitute specification, and originally-filed claim 5) explicitly recite that when R¹ and R² are saturated straight chains, they are limited to 3 to 20 carbon atoms. Applicant points to the structure recited in, e.g., originally-filed claim 7, as support for the new claim limitation. However, the single species is not sufficient to support a significant increase in the scope of the generic claim, especially in view of the contradictory originally-filed definition of the two variables.

5. Claims 5, 6, 49, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite because the same variable, L, is given two different definitions at line 10 and line 15 of the claim.

6. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Dependent claim 6 recites that R can be a saturated or unsaturated carbocyclic moiety of 3 to 20 atoms. However, with respect to cyclic groups, the independent claim limits R to being an aliphatic divalent cycloalkene [sic - cycloalkylene] group. Accordingly, dependent claim 6 is at least in part broader in scope than the independent claim and is therefore an improper dependent claim.

7. Applicant's arguments filed March 20, 2008 have been fully considered but they are not persuasive.

The objection under 37 CFR 1.75(c) of claim 6 is maintained. Applicant has deleted "saturated" from claim 6. However, the only cyclic R group recited in the independent claim, i.e. the aliphatic divalent cycloalkylene group, is saturated, not unsaturated. Applicant's amendment addressing this objection may have resulted from a misspelling in the examiner's objection. The examiner apologizes for any confusion his error may have caused.

Applicant has amended the specification so that "derivative" is defined as being a salt, ester, enol ether, enol ester, solvate or hydrate as set forth at page 9, line 20 - page 10, line 17, of the clean copy of the substitute specification filed March 20, 2008. Accordingly, the rejection under 35 U.S.C. 112, second paragraph, set forth in section 6 and the rejections under 35 U.S.C. 102 set forth in sections 10-12 of the Office action mailed October 16, 2007 have been overcome.

8. Claims 35 and 38 are allowed.

Art Unit: 1654

Claims 5, 6, 49, and 52 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, and the claim objections set forth in this Office action.

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:30 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached at (571) 272-0562. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

Art Unit: 1654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey E. Russel/
Primary Examiner, Art Unit 1654

JRussel
May 5, 2008